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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/286,906
Filing Date: April 06, 1999
Appellant(s): MISAWA, ATSUSHI

MAILED

DEC 29 2005

Technology Center 2600

Michael K. Mutter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 10/03/2005 appealing from the Office action
mailed on 11/03/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. Specifically, dependent claims 13, 22 and 25 are no longer rejected over Oku et al. in view of Okada, and are therefore objected to as allowable.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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4,977,456	Furuya	12-1990
JP 01-320871	Oku et al.	12-1989
US 2002/0008763	Kawamura et al.	01-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Oku et al. (JP 01-320871).

Regarding claim 1, Oku et al. disclose a camera comprising an imaging part (pickup circuit 21, figure 1, page 4, lines 22-28); a selector (combination of modes switches 31a, 31b and switch 5; recording mode is set by switch 31a and playback mode (reproducing mode) is selected by switch 5, figure 1, page 5, and see Constitution); a recording part (first recording head 441 and second recording head 443, figures 1-2, page 4, lines 29-34); a reproducing part (first playback head 442 and second playback 444, figures 1-2, page 4, lines 29-34); a monitor (electronic viewfinder 1, figure 1, page 4, line 22); a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode, and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first are being smaller than the

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second area (Oku et al. disclose that the display of the live recording image (by CAM) and the display of the reproduced image (by VTR) are displayed on electronic viewfinder 1 (figure 1), and the display of the live recording image (by CAM) is displayed in the central part of figure 7c which is smaller than the display of the reproduced image (by VTR), see figure 7c, page 8, line 9-13).

Regarding claim 14, Oku et al. disclose the display controller changes a size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode (figure 7c).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4, 15-21, 23-24, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku et al. (JP 01-320871) in view of Okada (US 5,515,104).

Regarding claim 2, Oku et al. fail to specifically disclose a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the camera; wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip. However, Okada discloses a camera has a grip (figure 1) and monitor (LCD 15) is arranged at a back of the body of the camera and extends to a part opposite to the grip (figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in

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Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

Regarding claim 3, Okada discloses the monitor is arranged such that a part of the second area and none of the first area are covered with the hand of the operator holding the camera by the grip in the recording mode (figure 2, LCD 15, when it is considered as first area, is not covered by the hand of the operator holding the camera by the grip). Oku et al., Figure 7c discloses the display area in VTR mode (a part of the second area) can be covered by the hand of an operator.

Regarding claim 4, Oku et al., Figure 7c discloses the display area in VTR mode (a part of the second area) can be covered by the hand of an operator.

Oku et al. fails to specifically disclose the monitor is arranged such that none of the first area is covered with the hand of the operator holding the body to operate the camera in the recording mode. However, Okada discloses a camera, in which LCD 15, when it is considered as first area, is not covered by the hand of the operator holding the camera (figures 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator can view the whole image while taking picture because the display is not covered by the hand of the operator.

Regarding claim 15, Oku et al. fail to specifically disclose wherein a back grip part at a side of the back of the camera which is held by a hand of an operator is made as a part of the display of the monitor, wherein the hand of the operator, during the recording mode, grips a part of the monitor. However, Okada discloses a camera has a grip (figure 1) and monitor (LCD 15) is arranged at a back of

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the body of the camera and extends to a part opposite to the grip (figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

Regarding claim 16, Oku et al., figure 7c, disclose the image captured in recording mode is displayed in the center part and is not displayed in the peripheral part which is used for the picture from the VTR, the VTR area can be covered by an operator's hand.

Regarding claim 17, Okada discloses lens 18 provided at the front face of the camera (figure 1) and can be covered by hand of an operator in viewing image in playback mode.

Regarding claim 18, Okada discloses the monitor is arranged in the back of the camera wherein a hand of an operator holding the camera extends to a portion of the monitor to cover the monitor by hand of the operator in order to hold the camera for taking picture (figures 1-2).

Regarding claim 19, Okada disclose a release button (shutter release 19, figure 1), wherein the monitor at the back of the body of the camera, extends to have a width which extends to at least interfere or cross over a line which is drawn vertically from the bottom of the release button to the bottom of the camera (se figures 1-2).

Regarding claim 20, Oku et al. disclose wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator (in figure 7c, the VTR area can be covered by the hand of an operator, the captured image displayed in CAM area is uncovered by the hand of an operator). Oku et al. do not disclose a back grip part at a side of the back of the camera which is held by a hand of an operator is made as apart of the display of the monitor. However, Okada discloses a camera has a grip and a display 15 in the back of the camera (figures 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture.

Regarding claim 21, Oku et al. disclose a camera comprising a selector (combination of modes switches 31a, 31b and switch 5; recording mode is set by switch 31a and playback mode (reproducing mode) is selected by switch 5, figure 1, page 5, and see Constitution); a reproducing part (first playback head 442 and second playback 444, figures 1-2, page 4, lines 29-34); a monitor (electronic viewfinder 1, figure 1, page 4, line 22).

Oku et al. fail to specifically disclose the monitor is displayed in the back of the body camera, wherein the camera is gripped, in at least one of the recording mode, wherein a part of the back of the body of the camera is covered while a member which is necessary for picture taking is kept uncovered by a hand of an operator and, the reproducing mode, the back of the body of the camera is kept uncovered by the a hand of the operator while a front of the body of the camera is covered; and wherein the monitor is arranged at such a position that a part of the monitor is covered by the hand of the operator if the camera

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is gripped in the recording mode whereas the entire area of the monitor is uncovered by the hand if the camera is gripped in the reproducing mode. However, Okada discloses a camera has a grip (figure 1) and monitor (LCD 15, rear cover 14, the area of the back of the camera corresponding to the grip) is arranged at a back of the body of the camera and extends to a part opposite to the grip (figure 2), in which in reproducing mode, the back of the body of the camera is kept uncovered by the hand of the operator (LCD 15 is not covered by the hand of the operator) while the front of the body of the camera is covered (the grip in front of the camera is covered by the hand of the operator). Okada also discloses the back of the camera corresponding to the grip is covered by the hand of the operator (the monitor is arranged at such a position that a part of the monitor is covered by the hand of the operator if the camera is gripped in the recording mode), and the operator can hold the camera in the position, which the bottom of the camera is in the hand of the operator, and the fingers grasp the lens 18, in this position, the monitor, which comprises LCD 15, rear cover 14, the area of the back of the camera corresponding to the grip, is not covered by the hand of the operator (the entire area of the monitor is uncovered by the hand if the camera is gripped in the reproducing mode).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Oku et al. by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

Regarding claim 23, Oku et al. disclose the camera switches the display of the monitor in response to the selector selecting one of the recording mode and the reproducing mode (switch 5, figure 1).

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Regarding claim 24, Okada discloses a lens (lens 18, figure 1). Oku et al. and Okada do not disclose a strobe as a member necessary for picture taking on the front of the body of the camera. However, Official Notice is taken that it is well known in the art to include a strobe on the front of the camera in order to provide sufficient light in taking picture. As Appellant has not traversed the old and well known statement, the use of a strobe in a camera is taken as admitted prior art. See MPEP 2144.03 (c). Therefore, it would have been obvious to one ordinary skill in the art to include a strobe on the front of the camera in order to provide sufficient light in taking picture.

Regarding claim 26, Oku et al. disclose the monitor displays the entirety of the image on the first area in the recording mode and the entirety of the image on the second area in the reproducing mode (Oku et al. disclose that the screen based on the recording picture signal and the screen based on the simultaneously playback picture signal are displayed alternately on the picture device (page 4, lines 1-6; page 5, lines 26-30), further in page 7, lines 22-25, Oku et al. disclose that logic circuit 7 outputs control signal Z to switch 5 so as to display picture signal CV picked up by video camera 2 and playback signal PV from VTR 4 alternately at the cycle of the pulse signal generated by timer circuit 6 during period III in Figure 3. This indicates that the entirety of the image on the first area in the recording mode and the entirety of the image on the second area in the reproducing mode).

Regarding claim 27, Oku et al. disclose that the screen based on the recording picture signal and the screen based on the simultaneously playback picture signal are displayed alternately on the picture device (page 4, lines 1-6; page 5, lines 26-30), further in page 7, lines 22-25, Oku et al. disclose that logic circuit 7 outputs control signal Z to switch 5 so as to display picture signal CV picked up by video

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camera 2 and playback signal PV from VTR 4 alternately at the cycle of the pulse signal generated by timer circuit 6 during period III in Figure 3. This shows that Oku et al. disclose displaying only the image captured by the imaging part on the monitor in the recording mode and displays only the image reproduced from the recording medium on the monitor in the reproducing mode.

5. Claims 6-8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku et al. (JP 01-320871) in view of Kawamura et al. (US 2002/0008763).

Regarding claim 6, Oku et al. fails to specifically disclose a touch panel arranged over the monitor; and wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part. However, Kawamura et al. disclose an electronic camera, which includes a touch panel (touch panel 2, figure 5, page 1, section [0022]); and operational button (buttons 25-27, figure 5) is displayed on an area other than the first area on the monitor in the recording mode (figure 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a touch panel as taught by Kawamura et al. in to the device in Oku et al. in order to provide an electronic camera has capability of entering data by means of a pen-type designator (page 1, section [0006]).

Regarding claim 7, Oku et al. and Kawamura et al. fail to specifically disclose wherein the operational button comprises at least one of a zoom operation button and an exposure correcting button. However, Official Notice is taken that it is well known in the art to use such zoom button to zoom image. As Appellant has not traversed the old and well known statement, the use of a zoom button in a camera is taken as admitted prior art. See MPEP 2144.03 (c). Therefore it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to include a zoom button in the device of Oku et al. and Kawamura et al. in order to let the user select a desired size of displayed image in viewing.

Regarding claim 8, Oku et al. fails to specifically disclose a touch panel arranged over the monitor. However, Kawamura et al. disclose an electronic camera, which includes a touch panel (touch panel 2, figure 5, page 1, section [0022]) and operational button (buttons 25-27, figure 5) is displayed on an area other than the first area on the monitor in the recording mode (figure 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a touch panel as taught by Kawamura et al. in to the device in Oku et al. in order to provide an electronic camera has capability of entering data by means of a pen-type designator (page 1, section [0006]).

Oku et al. and Kawamura et al. fail to specifically disclose at least one of an operational button for instructing the image reproduced on the monitor to be switched on a frame-by frame basis in an order, an operational button for instructing the image reproduced on the monitor to be switched on a frame-by frame basis in a reverse order, an operational button for instructing the image reproduced on the monitor to be enlarged, and an operational button for instructing the image reproduced on the monitor to be reduced, is displayed on the monitor in the reproducing mode. However, Kawamura et al. discloses and operational button (buttons 25-27, figure 5) is displayed on the monitor in the recording mode (figure 5).

And Official Notice is taken that it is well known in the art to use these buttons to perform function such as switching on a frame-by frame basis in an order and a reverse order, enlarging image displayed on the monitor, reducing image displayed on the monitor in order to let the operator saves time when reviewing image displayed on the monitor. As Appellant has not traversed the old and well known statement, the use of an operational button in a camera is taken as admitted prior art. See MPEP 2144.03 (c).

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Regarding claim 12, Oku et al. fails to specifically disclose first area is arranged to exclude an area covered with hand of an operator holding a body of the camera to operate the camera to record the image. However, Kawamura et al. disclose an electronic camera, which shows that the operator can hold the camera at the grip (an area covered with hand of an operator holding a body of the camera), which is excluded to display portion 4 (first area, figure 1A). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a zoom button in the device of Oku et al. by Kawamura et al. in order to let the operator can view the whole image while taking picture because the display is not covered by the hand of the operator.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oku et al. (JP 01-320871) in view of Furuya (US 4,977,456).

Regarding claim 9, Oku et al. fails to specifically disclose the monitor comprises a liquid crystal display. However, Furuya discloses an electronic viewfinder for displaying the video images captured in an attached electronic camera utilizes a liquid crystal display (see abstract, column1, lines 35-36). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a zoom button in the device of Oku et al. by Furuya in order to provide an image display device for use with video cameras which is compact and requires little electric power (column 1, lines 59-61).

Allowable Subject Matter

7. Claims 10-11 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claims 10-11, See Examiner's comments of reasons for the indication of allowable as indicated in Paper No. 16 mailed on 2/27/2004.

8. Claims 5, 13, 22, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 5, See Examiner's comments of reasons for the indication of allowable as indicated in Paper No. 8 on 12/19/2002.

Regarding claim 13, the prior art of the record fails to show or fairly suggest a camera comprising the display includes a third area wherein the third area is a marginal area on the display in which no image data appears and thereby provides a gripping area for the operator during the recording mode.

Regarding claim 22, the prior art of the record fails to show or fairly suggest a camera comprising a display controller to selectively switch between the first display mode and the second display mode in accordance with the selected gripping manner in the recording mode and the gripping manner in the reproducing mode.

Claim 25 is allowable for the reasons given in claim 22.

(10) Response to Argument

In re page 10, Appellant argues that Oku et al. fails to teach or suggest a selector for selecting one of a recording mode and a reproducing mode.

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In response, regarding claim 1, the Appellant recited limitation “a selector for selecting one of a recording mode and a reproducing mode.” The Examiner considers that claim 1 as recited still does not distinguish from Oku et al. patent. Oku et al. disclose the combination of mode switches 31a, 31b, and switch 5 as a selector, in which recording mode is set by switch 31a, the output CV of video camera 2 is supplied to an electronic view finder 1 through switch 5 when check mode switch 31b is not pressed. When check mode switch 31b is pressed, the switch 5 selects playback picture signal PV from VTR 4 (reproducing mode), the picture signal PV is supplied to the electronic viewfinder 1 (figure 1, pages 4-5, and see Constitution).

In re page 11, Appellant argues that Oku et al. fails to teach or suggest a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in a recording mode and to display the image reproduced from the recording medium on a second area on the monitor in a reproducing mode, the first area being smaller than the second area.

In response, regarding claim 1, the Appellant recited limitation “a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in a recording mode, and to display the image reproduced from the recording medium on a second area on the monitor in a reproducing mode, the first area being smaller than the second area.” The Examiner considers that claim 1 as recited still does not distinguish from Oku et al. patent. Oku et al. disclose that the display of the live recording image CV (by CAM) and the display reproduced image PV (by VTR) are displayed on electronic viewfinder 1 (figure 1, pages 4-5, see Constitution); and the display of the live recording image CV (by CAM) is displayed in

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the central part of figure 7c which is smaller than the display of the reproduced image (by VTR), see figure 7c, page 8, lines 9-13).

In re page 12, Appellant argues that Oku et al. fail to teach or suggest changing a size of an image displayed on the monitor in accordance with the switching between the recording mode and the reproducing mode, as set forth in dependent claim 14.

In response, regarding claim 14, the Appellant recited limitation “the display controller changes a size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode by the mode selector.” The Examiner considers that claim 14 as recited still does not distinguish from Oku et al. patent. Oku et al. disclose that the display of the live recording image CV (by CAM) and the display reproduced image PV (by VTR) are displayed on electronic viewfinder 1 (figure 1, pages 4-5, see Constitution); and the display of the live recording image CV (by CAM) is displayed in the central part of figure 7c which is smaller than the display of the reproduced image (by VTR), see figure 7c, page 8, lines 9-13). This indicates that there is a changing in size of an image displayed on the monitor in accordance with switching between the recording mode and the reproducing mode.

In re page 16, Appellant argues that Okada fails to teach or suggest wherein the hands of the operator holding the camera extends to a portion of the monitor to cover the monitor in order to hold the camera for taking pictures.

In response, regarding claim 2, the Appellant recited limitation “a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the

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camera; wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip.” The Examiner considers that Okada does disclose this feature. Okada discloses a camera has a grip being arranged at a front of the camera (figure 1), and LCD 15 (monitor) is arranged at a back of the body of the camera and extends to a part opposite to the grip (note that the grip is in the right side of figure 2; the LCD 15 extends to the left side of figure 2, this means that LCD 15 extends to a part opposite to the grip).

In re pages 17-18, regarding claim 2, Appellant argues that there is no suggestion or motivation for combining the Oku et al. and Okada references, and the rejection appears to rely on impermissible hindsight reasoning.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the grip for holding by a hand of an operator, as taught by Okada in figure 1, allows the operator hold the camera easier when taking pictures and viewing pictures at the same time.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the grip for holding by a hand of an operator, as taught by Okada in figure 1, allows the operator hold the camera easier when taking pictures and viewing pictures at the same time. Therefore, the examiner's conclusion of obviousness is seen as proper.

In re page 19, the Appellant disagrees that Okada discloses that the monitor is arranged such that a part of the second area is covered with the hand of the operator holding the camera by the grip in the recording mode.

In response, regarding claim 3, the Examiner considers that Okada does disclose this feature. Note that in Okada, the second area corresponds to LCD 15 in figure 2; an operator can cover a part of LCD 15 by his or her thumbs when holding the camera to take picture.

In re page 21, the Appellant's argument with respect to claim 13 is persuasive. Claim 13 has been indicated as allowable.

In re page 24, regarding claims 15 and 20, Appellant argues that Okada fails to teach or suggest wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera in the recording mode and wherein at least one of a captured image or a preview

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image is displayed on a part of the monitor which is uncovered by the based of the thumb of the operator.

In response, the Examiner considers that Okada does disclose wherein a part of the monitor is covered by the base of a thumb of the operator gripping the camera in the recording mode (figure 2 shows LCD 15 is arranged in the back of the camera; an operator can cover a part of LCD 15 by his or her thumbs when holding the camera to take picture), and wherein at least one of a captured image or a preview image is displayed on a part of the monitor which is uncovered by the base of the thumb of the operator (since the display of Oku et al. and Okada displays a captured imaged in the center of the display as shown in figure 7c of Oku et al., the captured imaged, which is displayed in the center of the display, is not covered by the base of the thumb of the operator).

In re pages 24-25, regarding claim 16, Appellant argues that Oku et al. fail to teach wherein the camera during the recording mode does not display the captured image or the previewed image on a part of the monitor which corresponds to the back grip, a part of the display of the monitor that is covered by the hand.

In response, the Examiner considers that Oku et al. does disclose this feature. Oku et al. disclose, in the figure 7c, the image captured in recording mode is displayed in the center part and is not displayed in the peripheral part which is used for the picture from the VTR, the peripheral part can be covered by an operator's hand.

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In re pages 25-26, regarding claim 17, Appellant argues that Okada fails to teach or suggest a gripping of a monitor. There is no teaching or suggestion in Okada that is directed to how a user may hold the camera when review images in the reproducing mode.

In response, regarding claim 17, the Appellant recited limitation “wherein one of a strobe and a lens provided at the front face of the camera is covered by a hand of the operator to hold the camera in the reproducing mode, whereby gripping the back of the camera can be avoided and a reproduced image is displayed on a portion corresponding to a gripping portion of the monitor.” The Examiner considers that Okada does disclose this feature. Okada, in figure 1, discloses lens 18 provided at the front of the camera. When the operator holds the lens 18 in the palm of the hand of the operator, lens 18 is covered, the operator can also view the image in the reproducing mode.

In re pages 27-28, regarding claim 21, Appellant argues that the Examiner has failed to provide proper motivation for combining the teaching Oku et al. and Okada references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the display LCD 15 at the back of the camera and the grip for holding by a hand of

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an operator, as taught by Okada in figures 1, 2, allow the operator hold the camera easier when taking pictures and viewing pictures at the same time.

In re pages 28-29, the Appellant's argument with respect to claims 22 and 25 are persuasive. Claims 22 and 25 have been indicated as allowable.

In re page 32, Appellant argues that Kawamura et al. teaches to utilize operational buttons 25-27 in order to select mode. There is no teaching or suggestion that these operational buttons may be utilized in the recording mode.

In response, regarding claim 6, it is noted that the feature "operational buttons may be utilized in the recording mode" is not a claim language. Instead, the Appellant recited limitation "wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode." The Examiner considers that Kawamura et al. do disclose this feature. Kawamura et al., in figure 5, disclose buttons 25-27 (operational button) are not displayed in the center of the touch panel 2, which corresponds to the first area on the monitor in the recording mode.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

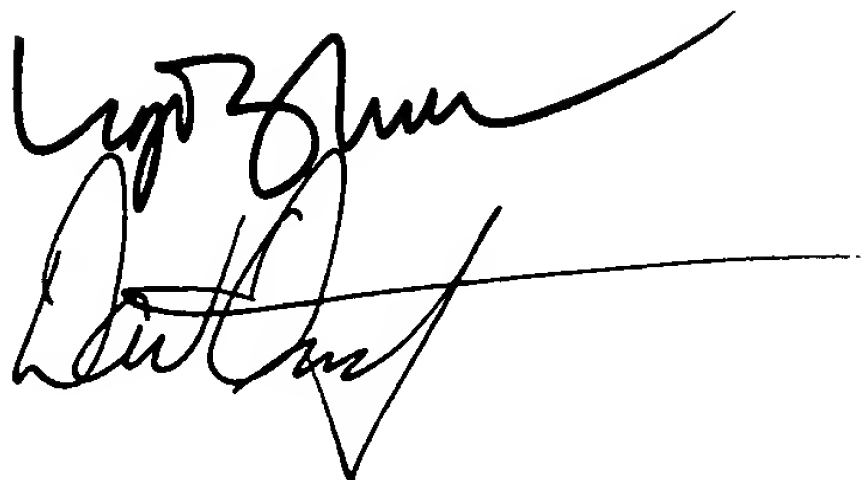
LN LN

December 22, 2005

Conferees:

NgocYen Vu, SPE Art Unit 2612

David Ometz, SPE Art Unit 2615

Two handwritten signatures are present. The top signature is for NgocYen Vu and the bottom signature is for David Ometz. Both signatures are in black ink and are written over a horizontal line.

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